

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on February 28, 2005. The application has been carefully reviewed in light of the Office action and interview, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Claims 55-82 remain in this application. Claims 1-55 have been previously canceled.

The Examiner objected to the abstract. A substitute abstract is attached hereto, making the objection moot.

The Examiner provisionally rejected claim 55, and claims 56-82, under the judicially created doctrine of obviousness-type double patenting with respect to application 10/733,981. The Examiner states that the claims are not patentably distinct.

Applicant traverses this rejection. The Examiner has admitted that the claims are different, but has provided no analysis to show how the changes would be "obvious" to one of ordinary skill in the art, or how one would be motivated to make the changes. Clearly, the Examiner has obtained the motivation from the application itself, which is improper hindsight motivation. Thus, the rejection is improper, and should be withdrawn. Furthermore, because neither application has matured into a patent, the rejection must be held into abeyance until one of the applications does so mature (and, of course, the rejection could not apply to the first application to mature into a patent).

Applicant's representative notes that claim amendments based on the personal interview are still being considered by applicant, and may be filed in this case in the near future.

Claims 55, 57-61, 63-67, 69-75 and 77-82 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mauldin *et al.* (U.S. 5,664,227). Claims 56, 62, 68 and 76 were rejected as above in further view of Ozsoyoglu *et al.* ("Automating the Assembly of Presentation from Multimedia Databases"). For the following reasons, the rejections are respectfully traversed.

As was discussed at the personal interview with the Examiner and her supervisor, the claims recite the context description data and the scores being input into the device (or a method of inputting scores). However, the Examiner argued that the term "input" is very broad in a

computer context. Even if true, none of the references teach *inputting* data according to the claims.

There is no suggestion in any of the references of inputting any data including "scores" as recited in the claims. In Mauldin, the Examiner is referring to the input of *video* data, which is not content description data. The Examiner cites Wilcox as teaching such a limitation. However, the cited section of Wilcox appears to teach only the "listing of segments ordered by their scores" (see Examiner cited section). The reference does not suggest any inputting of a score, or any selecting of such segments based on a score.

In addition, the "score" of Wilcox is not the same as the "score" of the claims. Wilcox defines the score according to the formula found in the reference. In contrast, the score of the application is defined in the claims as "attribute information" of the media content that is input. Wilcox does not suggest that its scores are attributes of the media content. Instead, the scores are calculated according to a formula, and thus are not *attributes*. At most, the combination of references may be argued to teach calculating a score. There is, however, no input function or database storage function disclosed. None of the other references overcome the discussed shortcomings. Accordingly, claims 55, 61, 67, and 75, are patentable over the references.

The remaining claims, which depend, directly or indirectly, upon one of claims 55, 61, 67, and 75, are patentable over the references for at least the same reasons as the parent claim. Furthermore, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the desirability of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

In response to previous arguments, the Examiner states that Mauldin's teaching of "keywords" meets the limitations to "scores" as recited in the claims. However, the references, in combination, merely discuss *internally* calculating such scores. There is no suggestion in any of the references of *inputting* any data including "scores" as recited in the claims. The claims specifically recite that the apparatus has the input means, not some internal component. Thus,

it must input from outside the apparatus, and that is not shown in the prior art. Thus, the claims are patentable over the references.

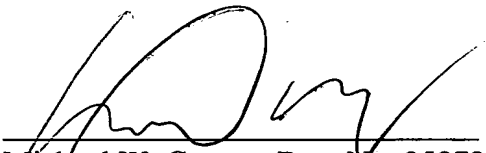
In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32161.

Respectfully submitted,

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